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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,330	01/29/2001	Carlos D. Fear	8569-013	8668

20583 7590 07/29/2003  
PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 07/29/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/772,330

Applicant(s)

FEAR, CARLOS D.

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_      6) ☐ Other: \_\_\_\_

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## **DETAILED ACTION**

### **Drawings**

An Official Draftsman has approved the drawings.

### **Oath/Declaration**

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The applicant has not stated in the declaration that he has invented or discovered and asexually reproduced the new and distinct plant. The declaration required of the applicant, in addition to the averments required by § 1.63, must state that he has asexually reproduced the plant. If the plant is a newly found plant, then the oath or declaration must also state that it was found in a cultivated area. A new declaration is required. See MPEP 1604.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

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**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

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- A. The Latin name of the genus, species and variety denomination of the claimed plant should be stated and preceded by the heading set forth in 37 CFR 1.163(c)(4), (c)(5) and (d). See MPEP 1605. Correction by adding such a name is required.
- B. Age of the observed plant should be disclosed in the specification. Correction is required.
- C. The specification does not "particularly point out where and in what manner the variety of plant has been asexually reproduced". Correction is required.
- D. Applicant should set forth in the specification the average primocane's length of the instant cultivar.
- E. On page 3 of Table 1, the recitation "medium" is vague and unclear and does not quantitatively describe the average yields in pounds per plant or per acre of the instant cultivar. Correction is necessary.
- F. Applicant should set forth in the specification the color designation of the floricanes and primocanes in the interest of providing as complete a botanical description of the plant as is reasonably possible.
- G. On page 4 of Table 1, the recitation "Relief between veins weak" is unclear as to how it relates to the leaves for the instant cultivar. Clarification is necessary.

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- H. On page 4, Table 1, the recitation "cordate" does not appear to correspond to Fig. 1 of the terminal leaflet shape. The terminal leaflet appears close to ovate, if accurate. Applicant should check for accuracy.
- I. Applicant should set forth in the specification the leaf surface textures of the upper and lower surfaces in the interest of providing as complete a botanical description of the plant as is reasonably possible.
- J. On page 4 of Table 1, the recitations regarding the pigmentation of the upper and lower surfaces of the petiole are vague and unclear because Applicant has not provided the color designation with reference from employed color chart for the instant cultivar. Correction is necessary.
- K. If available, applicant should set forth in the specification the stipule's average size, shape and color designation with reference to an employed color chart.
- L. On page 4 of Table 1, the recitation "late" is unclear as to when the bud burst and when the flowers begin to open. Applicant should set forth in the specification the approximate date of bud burst, bloom time, and duration of the blooms at a given location of culture.
- M. Applicant should set forth in the specification the number, shape, surface texture, and color designation with reference from an employed color chart of the petals in the interest of providing as complete a botanical description of the plant as is reasonably possible.

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N. On page 4 of Table 1, the recitation "short" is unclear as to the length of the pedicel.

Applicant should set forth in the specification the average length of pedicel.

O. Applicant should set forth in the specification the number, size, and color designation with reference from an employed color chart of the sepals in the interest of providing as complete a botanical description of the plant as is reasonably possible.

P. Applicant should set forth in the specification the reproductive organs and describe these structures (i.e. size, color designation, and number) in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

Q. Applicant should set forth in the specification the seed weight, seed size and seed color in the interest of providing as complete a botanical description of the plant as is reasonably possible, if produced or if not produced state -- none --.

R. If additional information is available relative pest resistance/susceptibility such should be set forth in the specification or if not observed state -- none observed --.

S. Applicant should import into the specification the plant hardiness zone or the heat/cold resistance for the claimed plant.

T. Applicant should set forth in the specification a brief statement regarding the market use of the fruit of the observed plant.

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U. Applicants should positively quantify known shipping and storage characteristics of the instant variety, such as for example, the number of days the fruit has been stored under specific conditions.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

### **Claim Rejection**

#### **35 USC § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

### **Amendments in a Revised Format Now Permitted**

The USPTO is permitting applicants to submit amendments in a revised format. The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121. Compliance to the revision to 37 CFR 1.121 (if adopted) will be mandatory by July of 2003. Complete details to the revised amendment format can be found on the Internet at

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>.

### **Future Correspondence**



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner can normally be reached Monday through Friday from 6:30 a.m. to 4:00 p.m. and off alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax numbers for the group are Before Final (703) 872-9306, After Final (703) 872-9307, and Customer Service (703) 872-9305.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service Center whose telephone number is (703) 308-0198.

JH

A handwritten signature in cursive script that reads "Bruce Campell".

BRUCE R. CAMPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600